

### **REMARKS**

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for courtesies extended during the in-person Examiner Interview conducted on October 19, 2005.

#### **Disposition of Claims**

Claims 1, 3-11, 13-18, and 20 are currently pending in this application. Claim 20 has been canceled by this reply. Claims 1, 11, and 18 are independent. The remaining claims depend, directly or indirectly, from claims 1, 11, and 18.

#### **Drawings**

Applicant again respectfully requests the Examiner to indicate whether the drawings filed on January 19, 2001, and corrected on September 24, 2004, are acceptable.

#### **Claim Amendments**

The independent claims of the present invention have been amended to clarify the present invention as recited. Specifically, the claims have been amended to include the steps taken by a manifest generator tool to generate manifest files for JES bundles. Specifically, as discussed with the Examiner during the in-person Examiner Interview conducted on October 19, 2005, the manifest generator tool is one of the plurality of tools in the module that aids in creating valid manifest files that are contained in JES bundles.

The amended claims recite that the manifest generator tool allows a user to create manifest files by checking a box next to a list of manifest header names that can be selected to be included in the manifest file. Subsequently, upon including the names of the manifest headers, the value of each header is entered into a text field next to the name of the manifest header. Next, a name for the manifest file is selected by the manifest generator tool and the tool ensures that a manifest file with the same name does not already exist. Using the aforementioned pieces of information, the manifest generator tool then generates the manifest file(s) for the JES bundles when the "create" button is pushed. (*see* Specification, pages 8-9).

No new subject matter is added by way of these amendments. Support for these amendments may be found in Figure 10 and on pages 8-9 of the Specification.

### **Rejections under 35 U.S.C. § 103**

Claims 1, 3-6, 8-11, 13-18, and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,633,888 (“Kobayashi”) in view of Admitted Prior Art submitted in the Affidavit 1.132 filed September 24, 2004 and Anne Thomas’ White Paper (“APA”). Claim 20 has been canceled by this reply. Thus, this rejection is now moot with respect to claim 20. To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

The claimed invention is directed toward a method of creating Java Embedded Server (JES) bundles using a manifest generator tool provided within a module that is executed in an Integrated Development Environment (IDE) (see, *e.g.*, Figure 7 and accompanying text on page 6-7 of the specification). As described above, the manifest generator tool is used to create and edit manifest files which are subsequently used to create a JES bundle (see Figure 10 and accompanying text on pages 8-9 of the Specification).

Turning to the rejection, to establish a *prima facie* case of obviousness “...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (See MPEP §2143.03). Further, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” (See MPEP §2143.03). The Applicant respectfully asserts that the references, when combined, fail to teach or suggest all the claim limitations of independent claims 1, 11, and 18.

Specifically, as discussed during the in-person Examiner Interview conducted on October 19, 2005, Kobayashi fails to disclose or suggest a manifest generator tool capable of generating manifest files for JES bundles while executing in an IDE. Particularly, Kobayashi fails to disclose or suggest that a manifest generator tool includes manifest header names by checking a box next to a list of manifest header names and entering values corresponding to the included manifest header names for the generation of manifest files. Further, Kobayashi fails to disclose or suggest a manifest generator tool configured to select a name for the manifest generator file(s)

and generate the manifest header files based on the entered manifest header names, values, and manifest file name.

Further, APA fails to provide that which Kobayashi lacks, as evidenced by the fact that the Examiner relies on APA solely for the purpose of disclosing that Java bundles are JES bundles and manifest files are JES manifest files. In particular, APA is completely silent with respect to a manifest generator tool, and thus cannot possibly disclose a manifest generator tool that performs the aforementioned steps to create manifest files for JES bundles.

Further, Applicant notes that there is no motivation to combine the teachings of Kobayashi and APA. The Examiner cannot combine prior art references to render a claimed invention obvious by merely showing that all the limitations of the claimed invention can be found in the prior art references. Instead, there must be a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must be an indication within the prior art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Further, the present application *cannot be used as a guide* in reconstructing elements of prior art references to render the claimed invention obvious. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added). In the present case, there is no expression of desirability in either Kobayashi or APA that would cause one skilled in the art to turn to the teachings of the other. Specifically, there is no suggestion or motivation in either APA or Kobayashi that leads one skilled in the art closer to the generation of JES bundles using tools in an IDE or making the creation of JES bundles easier. APA simply discloses Java bundles, but is not related to the generation of Java bundles, and Kobayashi discloses creating and testing object oriented components using visual programming systems (*see* Kobayashi, Abstract).

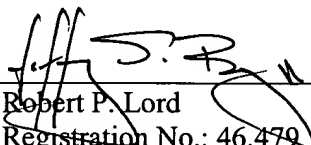
In view of the above, it is clear that neither Kobayashi nor APA, whether considered separately or in combination, render amended independent claim 1 obvious. Thus, amended independent claim 1 is patentable over Kobayashi and APA. Further, independent claims 11 and 18 have been amended to include similar allowable subject matter and are patentable over Kobayashi and APA for at least the same reasons as claim 1. Dependent claims 3-6, 8-10, and 13-17 are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

**Conclusion**

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 14695/007001).

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Respectfully submitted,

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